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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,051	11/26/2003	Lester F. Ludwig	A8681	8319

23373 7590 07/15/2005

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EXAMINER

DINH, DUNG C

ART UNIT PAPER NUMBER

2152

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary

Application No.

10/722,051

Applicant(s)

LUDWIG ET AL.

Examiner

Dung Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/26/03</u> | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION***Claim Rejections - Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 14, and 29 are are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,351,762 and further in view of Baumgartner et al. US patent 5,195,086.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite essentially the same limitations. For example:

Current claim 1	Pat '762 claim 2
(a) at least one communication device ...	(a) plurality of workstations
(b) at least one communication network ...	(b) AV path

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(c) at least one service record ... information associated with where the user logged in	(c) ... associate a participant only with the workstation at which the participant logs in
(d) computer software for causing display of a user identifier ...	inherent/obvious in the step of establishing the video conference.
(e) collaboration software ... retrieval of necessary addressing information, and cause to establish a connection ...	(c) AV conference manager

Pat '762 does not claim display and allow a user to select a second user identifier to establish a conference. In similar art of computer conference, Baumgartner teaches providing directory display and enable a selection of identifier to initiate a conference [fig.18]. It would have been obvious for one of ordinary skill in the art to provide display and permit selection of identifiers from the display because it would have provided a user-friendly interface for selecting participants in a conference. Claims 14 and 29 are similarly obvious over the Pat '762 claim 1.

Claims 1-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of Application No. 10/721,343, claims 1-42 of Application 10/721,905, claims 1-42 of Application 10/721,385. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because they recite essentially the same limitations. This is a provisional rejection because the claims are not in fact patented.

Claim Rejections - 35 USC § 112

Claims 3-6, 12-13, 15, 18-20, 23-24, 27-28, 30-31, 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "can be" renders the claim indefinite because it does not distinctly claim the subject matter. See MPEP § 2173.02.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vin et al "Multimedia Conferencing in the Etherphone Environment", and further in view of Baumgartner et al. US patent 5,195,086, Biswas "Distributed Scheduling of Meetings: A case study in Prototyping Distributed Applications" and Marshak "BeyondMail for Windows". (All references are cited in IDS filed 12/26/03).

As per claim 1, Vin teaches system for real-time communication essentially as claimed, comprising:

providing communication device having associated display (workstations);

at least one communication network to which the users log on [fig.1]; and

retrieval of addressing information to cause the establishing of a connection between the participants thereby enabling real-time communication among the participants including text and video [page.71 col.2 "The Etherphone Connection manager"].

Vin teaches forwarding call to workstation where the user logged in [p.72 col.2 line 11-15]. Hence, Vin inherently has a service record containing user identification and location where each user logged in order to forward the call. Furthermore, in similar field of user collaboration, Biswas discloses the need in

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an active communication system to track where a user logged in so as to enable display of message on the display device that a user is currently using. See page.627 col.1 1st paragraph. Hence, it would have been obvious for one of ordinary skill in the art to have service record with user identifier and the location (i.e. the workstation) where the user logged in because it would have enabled the system to route conference calls and messages to the correct location.

Vin does not specifically disclose displaying user identifiers for selection by the first user to establish a communication. In similar field of invention, Baumgartner teaches a conferencing system with directory displaying a list of potential participant for easy selection [see fig.18]. Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Baumgartner with Vin because it would have enabled a user-friendly method of selecting the participants.

As per claim 2, it is apparent that Vin system is capable of text messaging. Furthermore, Baumgartner teaches conferencing including realtime text-message exchange (col.14 lines 32-35 interactive data exchange).

As per claim 3, Vin and Baumgartner do not specifically disclose a wireless device. It would have been obvious for one

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of ordinary skill in the art to have a communication device being wireless device because it would have enabled the user to be mobile while participating in a conference.

As per claim 4, Baumgartner teaches the communication network is a wide area network (fig.14, 15).

As per claim 5, Baumgartner does not specifically disclose a selecting user identifier from a personalized list. Marshak discloses that it is known in the collaborative art to provide global and private directories (address books - see page 4 "Managing address book"). It would have been obvious for one of ordinary skill in the art to provide a personalized list because it would have enable the user to more efficiently group and identify the participants he wished to collaborate with.

As per claim 6, Baumgartner teaches the usage of graphical icon in the list [fig.18].

As per claim 7, it would have been obvious in the system as modified to indicate which user is logged on and which user is not so as to enable a participant to know who is available for participating in the conference.

As per claim 8, Vin teaches adding new participant [page 73 col.2].

As per claims 9-10, Vin teaches automatic notifying user of attempt to communicate [page 77 col.2 ringing]. It is apparent

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that the system as modified would allow communication to be established with a third user.

As per claim 11, Baumgartner teaches allowing user to send email [col.14 lines 22]

As per claims 14-28 they are rejected under similar rationale as claims 1-11 above. Baumgartner does not specifically disclose a selecting user identifier from a personalized list. Marshak discloses that it is known in the collaborative art to provide global and private directories (address books - see page 4 "Managing address book"). It would have been obvious for one of ordinary skill in the art to provide a personalized list because it would have enable the user to more efficiently group and identify the participants he wished to collaborate with.

As per claims 29-36, they are rejected under similar rationale as claims 1-11 above. Vin and Baumgartner do not teach a communication device being wireless or a mobile phone. Vin teaches permit a user to participate with audio only [p.72 col.2 "Best effort conferencing ... audio only"]. Hence, it would have been obvious for one of ordinary skill in the to use a mobile phone because it would have enable a user to participate while traveling. Baumgartner does not specifically disclose a selecting user identifier from a personalized list. Marshak discloses that it is known in the collaborative art to provide

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global and private directories (address books - see page 4 "Managing address book"). It would have been obvious for one of ordinary skill in the art to provide a personalized list because it would have enable the user to more efficiently group and identify the participants he wished to collaborate with.

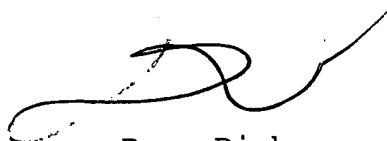
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (571) 272-3943. The examiner can normally be reached on Monday-Friday from 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (571) 272-3949.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dung Dinh
Primary Examiner
July 7, 2005